

REMARKS

Please reconsider the application in view of the above amendments and the following remarks. Applicant thanks the Examiner for carefully considering this application.

Disposition of Claims

Claims 1-5, 79-97, 111, and 112 were pending in this application. Claims 1-4 have been withdrawn from consideration as being directed to non-elected species covered by a generic claim. Claims 86 and 112 have been cancelled by way of this reply without prejudice or disclaimer. New claims 113-135 have been added by way of this reply. As such, claims 5, 79-85, 87-97, 111, and 113-135 are currently pending in this application. Claims 5 and 114 are independent. The remaining claims depend, directly or indirectly, from claims 5 and 114.

Amendments to the Claims

Claims 5, 85, and 96 have been amended by way of this reply. Specifically, independent claim 5 has been amended to correct an antecedent basis issue and to recite “drying the applied mixture at a drying temperature above the melting range of the wax.” Claim 85 has been amended to clarify that “the drying is carried out until a remaining water content is 7% or less.” Claim 96 has been amended to correct a minor typographical error. Support for these amendments may be found, for example, within paragraphs [0040], [0062], [0069], and [0084] of the published Specification. As such, no new matter has been added.

Claim Rejections under 35 U.S.C. § 112

Claims 5, 79-97, and 111-112 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 86 and 112 have been cancelled by way of this reply without prejudice or disclaimer. As such, this rejection is now moot with respect to claims 86 and 112. Further, claims 5, 85, and 96 have been amended by way of this reply. To the extent that this rejection may still apply to these claims, as amended, this rejection is respectfully traversed.

The Examiner asserts that “the supporting substrate” of independent claim 5 lacks antecedent basis. *See* Office Action of December 28, 2010, page 3. Independent claim 5 has been amended to recite “a supporting substrate.” Applicant respectfully asserts that amended independent claim 5 is clear and definite.

Further, the Examiner asserts that claim 85 is indefinite because the open ended ranges are conflicting and, thus, it is not clear what the water content range is. *See id.* As discussed above, claim 85 has been amended to clarify that “the drying is carried out until a remaining water content is 7% or less.” Applicant respectfully asserts that amended claim 85 is clear and definite.

Furthermore, the Examiner asserts that claim 96 is indefinite because it is not clear what a “Fischer-Tropsch-Wax” is. *See id.* Applicant respectfully disagrees. Applicant asserts that a Fischer-Tropsch-Wax is a term of art that has been clearly defined in paragraphs [0034]-[0035] of the published Specification and, thus, should not be objectionable.

Accordingly, withdrawal of this rejection is respectfully requested.

Claim Rejections under 35 U.S.C. § 103

Claims 5, 79, 81, 83, 84, 88, 90-92, 94, 95, 97, and 111

Claims 5, 79, 81, 83, 84, 88, 90-92, 94, 95, 97, and 111 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2003/0024637 (“Min”) in view of U.S. Patent No. 4,532,170 (“O’Dell”). Independent claim 5 has been amended by way of this reply. To the extent that this rejection may still apply to these claims, as amended, this rejection is respectfully traversed.

MPEP § 2143.03 requires consideration of every claim feature in an obviousness determination. The asserted combination of references must teach or suggest each and every claim feature. *See In re Royka*, 490 F.2d 981 (CCPA 1974); *In re Saether*, 492 F.2d 849, 852 (CCPA 1974). The Board of Patent Appeal and Interferences has recently confirmed that a proper obviousness determination requires that an Examiner make “a searching comparison of the claimed invention – including all its limitations – with the teaching of the prior art.” *See In re Wada and Murphy*, Appeal 2007-3733 (BPAI 2008) (citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995)). This rationale was recently supported by the Supreme Court holding that “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). This line of reasoning was further expanded upon by the Board of Patent Appeals and Interferences noting that when a reference is silent to an element, “it becomes

incumbent upon the Examiner to provide a basis in fact...that would support a finding [of the claim element being present].” *Ex Parte Sternby*, Appeal 2009-007462 (June 8, 2010) (non-precedential).

Amended independent claim 5 requires, in part, “drying the applied mixture at a drying temperature above the melting range of the wax.”

The Examiner admits that Min fails to disclose that the drying temperature is above the melting range of the wax. *See* Office Action of December 28, 2010, page 14.

Further, O’Dell fails to provide that which Min lacks. Specifically, O’Dell fails to show or suggest “drying the applied mixture at a drying temperature above the melting range of the wax,” as required by amended independent claim 5. In contrast, O’Dell discloses that the layer is dried at a drying temperature that is a minimum of 140 degrees F and that the melting point of the wax is 150-285 degrees F, preferably 220-230 degrees F. *See* O’Dell, column 4, lines 7-11 and column 6, lines 15-18. As such, O’Dell clearly teaches the use of a drying temperature that is *below* the melting range of the wax.

Applicant respectfully asserts that O’Dell fails to show or suggest each and every limitation of amended independent claim 5. Specifically, Applicant asserts that O’Dell fails to show or suggest “drying the applied mixture at a drying temperature above the melting range of the wax.” In fact, Applicant asserts that O’Dell teaches away from the claimed invention, and that one having ordinary skill in the art would not be motivated, in view of O’Dell, to use a drying temperature that is *above* the melting range of the wax, as O’Dell clearly teaches the use of a drying temperature that is *below* the melting range of the wax.

In view of the above, it is clear that the Examiner's contentions fail to support an obviousness rejection of amended independent claim 5. Thus, amended independent claim 5 is patentable over Min in view of O'Dell. Claims 5, 79, 81, 83, 84, 88, 90-92, 94, 95, 97, and 111, which depend from amended independent claim 5, are patentable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claim 80

Claim 80 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Min in view of O'Dell, in further view of U.S. Patent Publication No. 2005/0186399 ("Taylor"). Claim 80 depends from amended independent claim 5. To the extent that this rejection may still apply to these claims, as amended, this rejection is respectfully traversed.

As discussed above, both Min and O'Dell, whether considered separately or in combination, fail to show or suggest "drying the applied mixture at a drying temperature above the melting range of the wax," as required by amended independent claim 5.

Taylor fails to provide that which Min and O'Dell lack. Specifically, Taylor is completely silent with regard to a drying temperature that is above the melting range of the wax.

In view of the above, it is clear that the Examiner's contentions fail to support an obviousness rejection of amended independent claim 5. Thus, amended independent claim 5 is patentable over Min in view of O'Dell, in further view of Taylor. Claim 80, which depends from

amended independent claim 5, is patentable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 84, 87, and 89

Claims 84, 87, and 89 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Min in view of O'Dell, in further view of U.S. Patent No. 4,478,660 ("Lander"). Claims 84, 87, and 89 depend from amended independent claim 5. To the extent that this rejection may still apply to these claims, as amended, this rejection is respectfully traversed.

As discussed above, both Min and O'Dell, whether considered separately or in combination, fail to show or suggest "drying the applied mixture at a drying temperature above the melting range of the wax," as required by amended independent claim 5.

Lander fails to provide that which Min and O'Dell lack. Specifically, Lander is completely silent with regard to a drying temperature that is above the melting range of the wax.

In view of the above, it is clear that the Examiner's contentions fail to support an obviousness rejection of amended independent claim 5. Thus, amended independent claim 5 is patentable over Min in view of O'Dell, in further view of Lander. Claims 84, 87, and 89, which depend from amended independent claim 5, are patentable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 82, 85-89, and 112

Claims 82, 85-89, and 112 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Min in view of O'Dell, in further view of U.S. Patent No. 4,250,282 ("Dorries"). Claims 86 and 112 have been cancelled by way of this reply without prejudice or disclaimer. As such, this rejection is now moot with respect to claims 86 and 112. Claims 82, 85, and 87-89 depend from amended independent claim 5. To the extent that this rejection may still apply to these claims, as amended, this rejection is respectfully traversed.

As discussed above, both Min and O'Dell, whether considered separately or in combination, fail to show or suggest "drying the applied mixture at a drying temperature above the melting range of the wax," as required by amended independent claim 5.

Dorries fails to provide that which Min and O'Dell lack. Specifically, Dorries is completely silent with regard to a wax at all, let alone a drying temperature that is above the melting range of the wax.

In view of the above, it is clear that the Examiner's contentions fail to support an obviousness rejection of amended independent claim 5. Thus, amended independent claim 5 is patentable over Min in view of O'Dell, in further view of Dorries. Claims 82, 85, and 87-89, which depend from amended independent claim 5, are patentable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claim 93

Claim 93 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Min in view of O'Dell, in further view of U.S. Patent No. 5,545,476 ("O'Dell '476"). Claim 93 depends from amended independent claim 5. To the extent that this rejection may still apply to these claims, as amended, this rejection is respectfully traversed.

As discussed above, both Min and O'Dell, whether considered separately or in combination, fail to show or suggest "drying the applied mixture at a drying temperature above the melting range of the wax," as required by amended independent claim 5.

O'Dell '476 fails to provide that which Min and O'Dell lack. Specifically, O'Dell '476 is completely silent with regard to a drying temperature that is above the melting range of the wax.

In view of the above, it is clear that the Examiner's contentions fail to support an obviousness rejection of amended independent claim 5. Thus, amended independent claim 5 is patentable over Min in view of O'Dell, in further view of O'Dell '476. Claim 93, which depends from amended independent claim 5, is patentable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claim 96

Claim 96 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Min in view of O'Dell, in further view of Chemical Plus data sheet ("Chemical Plus"). Claim 96 has been

amended by way of this reply and depends from amended independent claim 5. To the extent that this rejection may still apply to these claims, as amended, this rejection is respectfully traversed.

As discussed above, both Min and O'Dell, whether considered separately or in combination, fail to show or suggest "drying the applied mixture at a drying temperature above the melting range of the wax," as required by amended independent claim 5.

Chemical Plus fails to provide that which Min and O'Dell lack. Specifically, Chemical Plus is completely silent with regard to a drying temperature that is above the melting range of the wax.

In view of the above, it is clear that the Examiner's contentions fail to support an obviousness rejection of amended independent claim 5. Thus, amended independent claim 5 is patentable over Min in view of O'Dell, in further view of Chemical Plus. Claim 96, which depends from amended independent claim 5, is patentable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

New Claims

New claims 113-135 have been added by way of this reply. Support for the new claims can be found, for example, within the originally filed claims and within Figures 1-3 and pages 1-8 of the published Specification. As such, no new matter has been added.

New claim 113 depends from amended independent claim 5, and is patentable over Min, O'Dell, Taylor, Lander, Dorries, O'Dell '476, and Chemical Plus for at least the same reasons.

New independent claim 114 requires, in part, “drying the decorative layer with the applied mixture before the pressing, and at a drying temperature within a drying temperature range below the press temperature” and that “a drying time is from 1 to 3 minutes.”

The Examiner admits that Min fails to disclose a drying time from 1 to 3 minutes. *See* Office Action of December 28, 2010, page 13.

Further, O’Dell, Taylor, Lander, Dorries, O’Dell ‘476, and Chemical Plus, each fail to provide that which Min lacks. Specifically, O’Dell, Taylor, Lander, Dorries, O’Dell ‘476, and Chemical Plus each fail to show or suggest a drying time from 1 to 3 minutes.

The Examiner asserts that Dorries teaches dwell times of 90 seconds in Example 7, 60 seconds in Example 8, and 3 minutes in Example 2. *See id.* However, Applicant respectfully asserts that Dorries is completely silent with regard to a wax at all. Further, it appears that the Examiner has mischaracterized the dwell time of Dorries to be equivalent to the drying time of the claimed invention.

New independent claim 114 requires drying the decorative layer with the applied mixture *before the pressing*. In other words, drying and pressing, as required in the claimed invention, are *distinct* and cannot be considered to be the same. Applicant asserts that the dwell time of Dorries is a pressing time and *not a drying time*. For example, according to Example 7 of Dorries, the curing rating is determined in the Kiton test after pressing for 60 seconds at 160° C and for 90 seconds at 175 ° C. *See* Dorries, column 12, lines 31-40. Further, according to Example 8 of Dorries, the dwell time *in the press* is 60 seconds. *See* Dorries, column 13, lines 14-15. As such,

the dwell time of Dorries is *a pressing time*, which the Examiner improperly equates to the drying time of 1-3 minutes of the claimed invention. As such, Applicant respectfully asserts that one having ordinary skill in the art would not be motivated, in view of Dorries, to use a drying time from 1 to 3 minutes. Dorries clearly teaches a *pressing time* of 60 seconds, 90 seconds, and 3 minutes, and is completely silent with regard to a drying time from 1 to 3 minutes, as required by new independent claim 114.

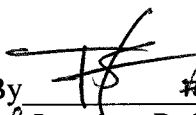
In view of the above, Min, O'Dell, Taylor, Lander, Dorries, O'Dell '476, and Chemical Plus, whether considered separately or in combination, fail to show or suggest all of the elements of new independent claim 114. As such, new independent claim 114 is patentable over Min, O'Dell, Taylor, Lander, Dorries, O'Dell '476, and Chemical Plus. New claims 115-135 are patentable for at least the same reasons.

Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 03850/029001).

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Respectfully submitted,

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